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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,914	01/20/2005	Keyvan Mazda	1107-050118	7041
28289 7590 07/30/2007 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER CUMBERLEDGE, JERRY L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,914

Applicant(s)

MAZDA ET AL.

Examiner

Jerry Cumberledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Wyckoff (US Pat. 902,040).

Wyckoff discloses a vertebral fixing system adapted to be mounted on a vertebra of the spine comprising a rod (Fig. 2, ref. k) capable of being connected to the vertebra of the spine, said vertebra having a posterior wall in the vicinity of which said rod extends and lateral walls from which project ribs and/or transverse processes, said vertebral fixing system comprising: a connecting part (Fig. 3, refs. a and b) comprising first and second longitudinal members (Fig. 3, refs. a and b) adapted to face said rib and/or said transverse process and to be connected to said rod; an elongate flexible (first column, lines 26-27) ligature (Fig. 4, ref. 16) adapted to connect together said connecting part and at least one rib and/or one transverse process; and adjustable locking means (Fig. 3, refs. C, E, J) fastened to said connecting part (Fig. 1), said locking means being adapted to fix simultaneously in position said connecting part relative to said rod and one portion of said ligature (Fig. 4, near ref A) between said first and second longitudinal members, and said ligature being adapted to be immobilized in translation relative to said connecting part by said adjustable locking means, whereby a

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loop (Fig. 4, near ref 16) of the ligature has a particular length, so as to prevent relative displacement of said rod and said vertebra in opposite directions, wherein said two longitudinal members (Fig. 2, refs. a and b) comprise first and second ends, wherein said first ends are connected together so that said members may pivot relative to each other (Fig. 2, ref. r) and middle parts (Fig. 2, middle portions of ref. a and b) of their two facing faces are adapted to bear on respective opposite sides of said rod, said adjustable locking means being adapted to drive the second ends of said longitudinal members forcibly towards each other and to fix them in position relative to each other so that said two members form a clamp and grip said rod, whereby said connecting part can be fixed in position relative to said rod, wherein said second ends of said two longitudinal members have, facing each other, a bore in a first longitudinal member (Fig. 2, ref. j) and a thread in a second longitudinal member (second column, lines 68-72), so that a screw (Fig. 2, ref. c) may be passed through said bore and screwed into said thread to form said adjustable locking means, and wherein said first end of said ligature is fastened to a pivot (Fig. 2, ref. 12) of said longitudinal members.

With regard to statements of intended use and other functional statements (e.g. "...adapted to connect to..." "...adapted to fix simultaneously..." "...adapted to be immobilized..."), they do not impose any structural limitations on the claims distinguishable over the devices of Golds et al. and Steffee, which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it

is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fiz* (U.S. Pat. 6,179,838) in view of *Burgess et al.* (WO 0209604 A1).

Fiz discloses a vertebral fixing system (Fig. 6 below) adapted to be mounted on a vertebra of the spine comprising: to connect it to a rod, a rod (Fig. 6, ref. 4) capable of being connected to the vertebra of the spine, said vertebra having a posterior wall in the vicinity of which said rod extends and lateral walls from which project ribs and/or transverse processes; a connecting part (Fig. 6, below) adapted to face said rib and/or said transverse process and to be connected to said rod, said connecting part having a first face facing said rib and/or said process and a second face opposed to said first face comprising first and second longitudinal members pivotally connected at a pivot (Fig. 6, ref. 48) adjacent the first face and being provided with fastening means;

adjustable locking means fastened to said connecting part, said locking means being adapted to fix simultaneously in position said connecting part relative to said rod. The connecting part includes a passage (as seen in cross section, Fig. 8 below) facing said rod. The first and second connecting part comprises two longitudinal members (Fig. 6 below) comprising first ends (Fig. 6 ends near ref. 14) are connected together so that said members may pivot relative to each other and middle parts of their two facing faces are adapted to bear on respective opposite sides of said rod, said adjustable locking means being adapted to drive the second ends of said longitudinal members forcibly towards each other and to fix them in position relative to each other so that said two members form a clamp and grip said rod, whereby said connecting part can be fixed in position relative to said rod. The second ends of said two longitudinal members have, facing each other, a bore (Fig. 9, below) a first longitudinal member and a thread in a second longitudinal member, so that a screw may be passed through said bore and screwed into said thread to form said adjustable locking means. At least one of the middle parts of said two facing faces has a first portion (Fig. 8) through which a passage passes and a second portion adapted to bear against said rod. The passage extends between two orifices in said connecting part and opening to the outside of said part (Fig. 9 below). Each of said middle parts of said two longitudinal members includes an orifice (Fig. 8 below). The passage has a section that decreases from one orifice to the other.

Fiz discloses a vertebral fixing system adapted to be mounted on a vertebra of the spine comprising: a rod (Fig. 6, ref. 4) capable of being connected to the vertebra of the spine, said vertebra having a posterior wall in the vicinity of which said rod extends

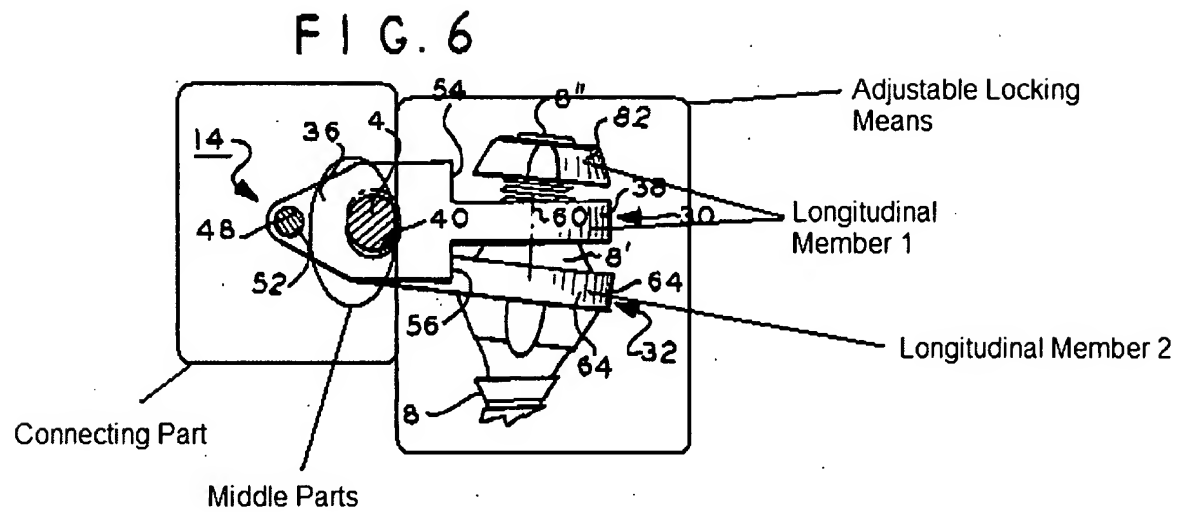
and lateral walls from which project ribs and/or transverse processes; a connecting part (Fig. 6, below), separate from the rod (Fig. 6), comprising first and second longitudinal members pivotally connected at a pivot (Fig. 6, near ref. 48) and adapted to face said rib and/or said transverse process and to be connected to said rod; and adjustable locking means (Fig. 6 below) fastened to said connecting part, said locking means being adapted to fix simultaneously in position said connecting part relative to said rod, wherein said connecting part includes a passage (Fig. 8 below) facing said rod.

Fiz does not disclose a flexible ligature having a first end secured to the fastening means, a first portion forming a loop, the first portion facing the first face of the connecting part and a second free end projecting out of the second face and having an end fastened to the pivot.

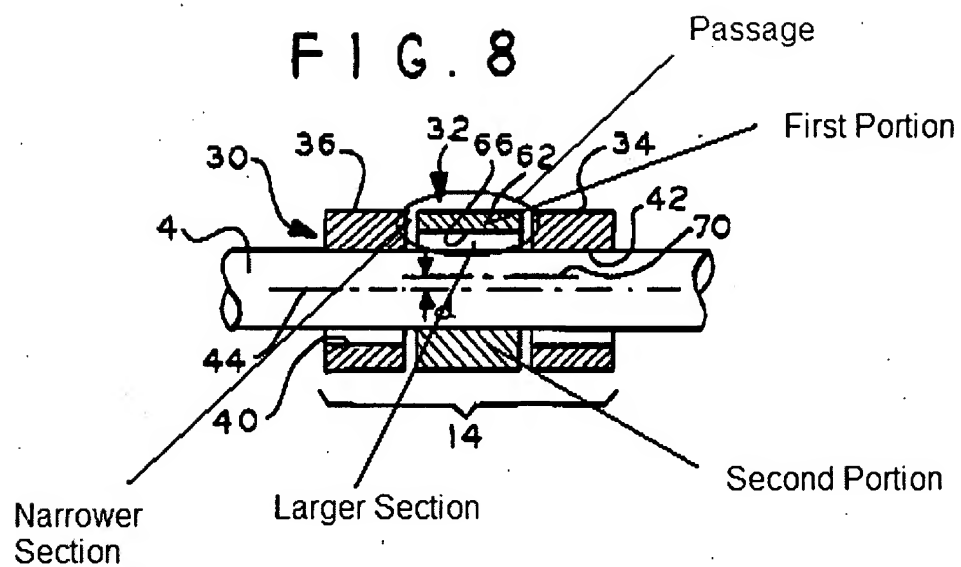
Burgess et al. disclose a flexible ligature having a first end (Fig. 6, far bottom) secured to the fastening means, a first portion forming a loop (Fig. 6, near ref. numerals 32), the first portion facing the first face of the connecting part (Fig. 6, the portion of ref. 1 that the ligature faces) and a second free end projecting out of the second face (Fig. 6, far bottom), the ligature being used for attaching the vertebral fixing system to the spine (page 2, paragraph 2, lines 1-3).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the vertebral fixing system of Fiz with the ligature attached to the connecting device of Burgess, in order to use the ligament to attach the vertebral fixing device to the spine.

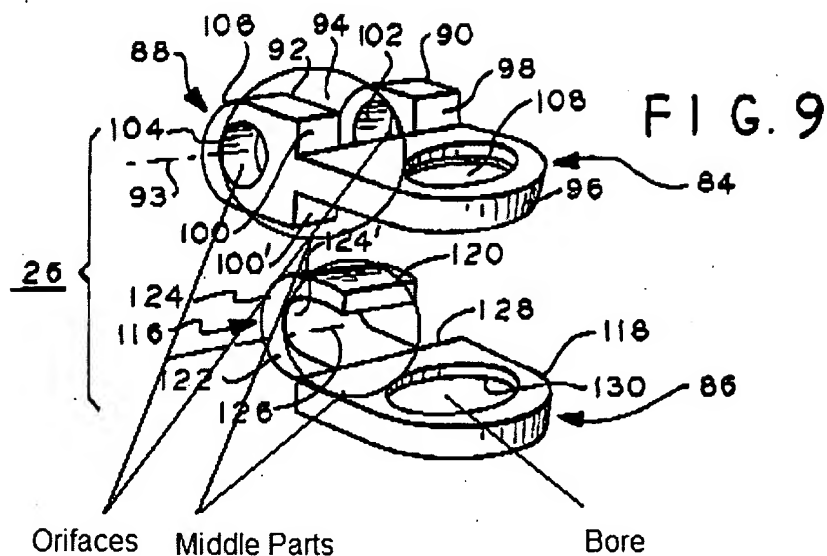
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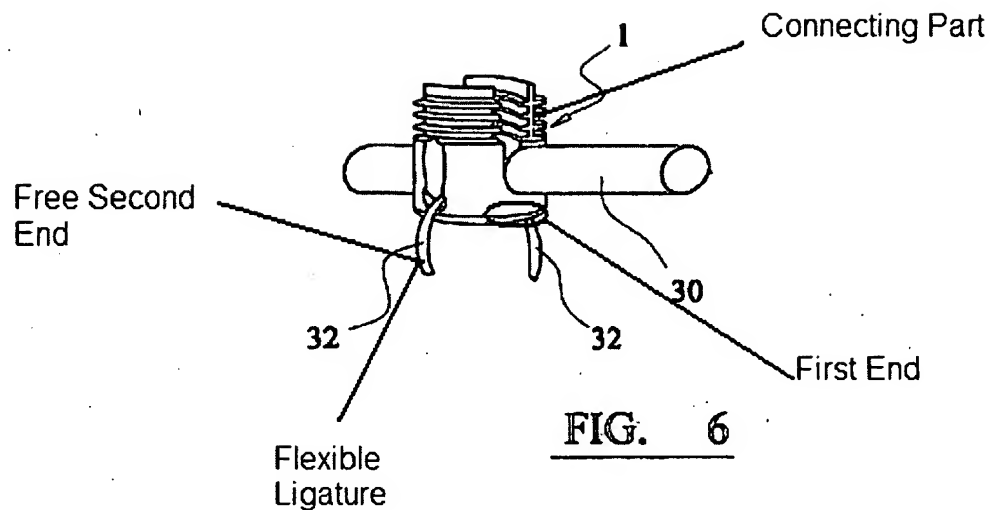


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Response to Arguments

With regard to Applicant's argument that Wyckoff does not disclose a rod capable of being connected to the vertebra of the spine, the Examiner respectfully disagrees. See above rejection under 35 U.S.C. 102(b). With regard to applicant's argument that the device of Wyckoff is not intended to be used as a vertebral fixing system, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With regard to Applicant's argument that Fiz in combination with Burgess does not disclose a flexible ligature having an end fastened to the pivot of the connecting part as recited, the Examiner respectfully disagrees. While the ligature would not be *directly* fastened to the pivot, the ligature would be fastened to the pivot, as it would be fastened to every other part of the device once the device is constructed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571)

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272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO G. ROBERT
SUPERVISORY PATENT EXAMINER